

REMARKS

This response is intended as a full and complete response to the final Office Action mailed May 16, 2006. In the Office Action, the Examiner notes that claims 1-23 are pending and rejected. By this response, Applicant has amended claim 3.

In view of both the amendments presented above and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, Applicant respectfully submits that all of the claims contain satisfy the requirements of 35 U.S.C. §112. Thus, Applicant believes that all of the claims are now in allowable form.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

Amendments to the Claims

By this response, Applicant has amended claim 3. The amendments are fully supported by the Application as originally filed as stated in the previous response.

Entry of this amendment is proper under 37 CFR 1.116 since the amendment places the application in condition for allowance for reasons discussed herein; satisfy a requirement of form asserted in the previous Office Action; and places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to issue raised in the final rejection. Entry of this amendment is thus respectfully requested.

35 U.S.C. §112, ¶1 Rejection of Claim 3

The Examiner has rejected claim 3 under 35 U.S.C. 112, ¶1, as failing to comply with the written description requirements. In particular, the Examiner finds that claim 3 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. Applicant respectfully traverses the rejection.

As amended, claim 3 recites in part "at least one favorite channels menu displaying at least some of the plurality of favorite channels; and at least one favorite programs menu displaying at least some of the plurality of favorite programs." This feature is fully disclosed in the parent application at least by page 60, lines 17-19; and page 105, line 1 to page 106, line 5. Thus, the newly amended claim 3 satisfies the written description requirements. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 22 and 23

The Examiner has rejected claims 22 and 23 under 35 U.S.C. §103(a) as being anticipated by U.S. Patent 5,477,262 to Banker et al. (hereinafter "Banker") in view of U.S. Patent 5,404,393 to Remillard (hereinafter "Remillard"). Applicant respectfully traverses the rejection.

Claim 22 recites:

22. An interactive electronic program guide for controlling display of content on a television associated with a set top terminal, the guide comprising:

- a plurality of interactive menus, each corresponding to a level of interactivity and having one or more interactive menu items for selection;

- a main menu having one or more main menu items for selection, which main menu items correspond to the interactive menus;

- a mask to mask portions of a video, wherein a first graphic representing the mask is stored in a first graphics file in a memory of the set top terminal; and

- a cursor highlight overlay to indicate the position of a cursor on at least one of the menus, wherein the cursor highlight overlay is movable in response to pressing of cursor movement buttons by a user, and wherein a second graphic representing the cursor highlight overlay is stored in a second graphics file in the memory of the set top terminal,

- wherein the cursor highlight overlay is displayed over the at least one of the menus which is displayed over the mask, and

- wherein the menus are navigated using a user input, and wherein the main menu items and the interactive menu items are responsive to selection signals received from the user input.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Banker and Remillard references alone or in combination fail to teach or suggest Applicant's invention as a whole.

Specifically, the Banker reference fails to teach or suggest at least "wherein the cursor highlight overlay is displayed over the at least one of the menus, which is displayed over the mask," as recited in independent claim 22.

The Banker reference discloses an "[a]pparatus for providing a user friendly interface to a subscription television terminal comprises a key pad arranged into a plurality of key groupings and an on-screen display controller for generating a plurality of screens for display on an associated television receiver" (abstract). Specifically, the Banker reference discloses (emphasis added below):

"The on-screen display is selectively overlaid on the video signal, so a viewer can continue to watch a program, or provide in place of the program video with a suitable plain-colored background."
(column 11, lines 24-28)

Thus, the Banker reference discloses an on-screen display that is overlaid on the video signal or is provided in place of the program video. Overlaying and replacing are different than masking. Therefore, the Banker reference does not teach or suggest a mask to mask portions of a video and displaying a menu over the mask. Because Banker is silent with respect to the mask, the Banker reference also does not teach or suggest that the cursor highlight overlay is displayed over a menu which is displayed over the mask.

The Remillard reference fails to bridge the substantial gap between the Banker reference and Applicant's invention. In particular, Remillard discloses an electronic device that provides for windowed display of the menu (overlaying the interaction menus on a portion of a convention television broadcast, for example) and construction

of a viewing profile, among other things." (column. 5, lines 56-61). Thus, Remillard discloses overlaying menu. Remillard is silent with respect to a mask as claimed. Nowhere in Remillard is there any teaching or suggest of at least Applicant's claimed the cursor highlight overlay is displayed over a menu which is displayed over the mask.

As such, claim 22 is patentable over Banker in view of Remillard under 35 U.S.C. §103(a). Claim 23 contains substantially similar relevant limitations as discussed above in regards to claim 22. Accordingly, Applicant submits that claim 23 also is patentable over Banker in view of Remillard under 35 U.S.C. §103(a).

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 8-21

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Banker in view of Remillard and U.S. Patent 5,539,871 to Gibson (hereinafter "Gibson"). Applicant respectfully traverses the rejection.

For at least the reasons discussed above the Banker and Remillard references alone or in combination fail to teach or suggest Applicant's invention as a whole. The Gibson reference fails to bridge the substantial gap between the Banker and Remillard references and Applicant's invention.

Specifically, the Gibson reference also fails to teach or suggest at least "wherein the cursor highlight overlay is displayed over the at least one of the menus, which is displayed over the mask," as recited in claim 8 as amended.

The Gibson reference discloses a "method and system in a data processing system for selectively associating stored data with an animated element within a multimedia presentation in a data processing system" (abstract). However, the Gibson reference does not teach or suggest at least a mask to mask portions of a video. Thus, the Gibson reference also does not teach or suggest that the cursor highlight overlay is displayed over a menu which is displayed over the mask.

As such, Applicant's independent claim 8 is patentable under 35 U.S.C. §103(a) over Banker in view of Remillard and Gibson. Furthermore, claims 9-21 depend, directly or indirectly from independent claim 8, while adding additional elements.

Therefore, 9-21 are also non-obvious and patentable over Banker in view of Remillard and Gibson under §103 for at least the same reasons that claim 8 is patentable over Banker in view of Remillard and Gibson under §103.

Therefore, Applicant respectfully requests that the Examiner's rejection of claims 13-15, 17-19 and 21 U.S.C. §103(a) be withdrawn.

35 U.S.C. §103 Rejection of Claims 1 and 7

The Examiner has rejected claims 1 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,410,326 to Goldstein in view of Banker and Remillard. Applicant respectfully traverses the rejection.

Applicant's claim 1 recites:

1. An interactive electronic program guide for display on a television for use with a television delivery system comprising a set top terminal, the guide comprising:
 - a home menu;
 - a plurality of major menus displayed as menu options on the home menu;
 - a plurality of sub-menus displayed as menu options on the plurality of major menus;
 - a plurality of during programming menus enacted after selection of a program;
 - a mask to mask portions of a video, wherein a first graphic representing the mask is stored in a first graphics file in a memory of the set top terminal; and
 - a cursor highlight overlay to indicate the position of a cursor on at least one of the menus, wherein the cursor highlight overlay is movable in response to pressing of cursor movement buttons by a user, and wherein a second graphic representing the cursor highlight overlay is stored in a second graphics file in the memory of the set top terminal,
 - wherein the cursor highlight overlay is displayed over the at least one of the menus which is displayed over the mask. (emphasis added).

For at least the reasons discussed above, the Banker and Remillard references alone or in combination fail to teach or suggest Applicant's invention as a whole. The Goldstein reference fails to bridge the substantial gap between the Banker and Remillard references and Applicant's invention as claimed in claim 1.

Specifically, the Goldstein reference also fails to teach or suggest at least "a mask to mask portions of a video" and "wherein the cursor highlight overlay is displayed

over the at least one of the menus, which is displayed over the mask" as recited in the claim as amended.

The Goldstein reference discloses a "universal remote control device which is programmed to operate a variety of consumer products" (Abstract). However, the Goldstein reference does not teach or suggest a mask to mask a video. Therefore, the Goldstein reference also does not teach or suggest that the cursor highlight overlay is displayed over a menu which is displayed over the mask.

As such, Applicant's independent claim 1 is patentable under 35 U.S.C. §103(a) over Goldstein in view of Banker and Remillard. Furthermore, claim 7 depends directly from independent claim 1, while adding additional elements. Therefore, claim 7 is also patentable over Goldstein in view of Banker and Remillard under §103 for at least the same reasons that claim 1 is patentable over Goldstein in view of Banker and Remillard under §103.

Therefore, Applicant respectfully requests that the Examiner's rejection of claims 1 and 7 under U.S.C. §103(a) be withdrawn.

35 U.S.C. §103 Rejection of Claims 2-6

The Examiner has rejected claims 2-6 under 35 U.S.C. §103(a) as being unpatentable over Goldstein, Banker and Remillard, as applied to claim 1 above, and further in view of U.S. Patent 5,047,867 to Strubbe et al. (hereinafter "Strubbe"). Applicant respectfully traverses the rejection.

Each of the grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 for the corresponding independent claims. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office that any other additional references supply that which is missing from Goldstein, Banker and Remillard to render the independent claims unpatentable, these grounds of rejection cannot be maintained.

Therefore, Applicant respectfully requests that the Examiner's rejection of claims 2-6 under U.S.C. §103(a) be withdrawn.

CONCLUSION

Thus, Applicant submits that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jasper Kwoh, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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